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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,332	10/23/2001	Masaki Ohira	16869P-027000US	9285
20350	7590	03/27/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			LI, SHI K	
TWO EMBARCADERO CENTER			ART UNIT	
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SAN FRANCISCO, CA 94111-3834			2613	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/038,332	Applicant(s) OHIRA ET AL.	
	Examiner Shi K. Li	Art Unit 2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-20 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-11,36 and 37 is/are rejected.
- 7) ☒ Claim(s) 12-20 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-3,5-6 and 36 are objected to because of the following informalities: claim 1 recites "determining a first monitoring parameters signal" in line 15 of the claim. Comparing with other limitations, it appears that the word 'signal' is extra and should be deleted. Appropriate correction is required.
2. Claims 12-20 and 38 are objected to because of the following informalities: claim 12 recites "said first end-point devices" in line 16 of the claim. It should read "said first end-point device"; claim 12 recites "said third end-point devices" in lines 23-24 of the claim. It should read "said third end-point device". Appropriate correction is required.
3. Claim 15 is objected to because of the following informalities: claim 15 recites "said first and second portions" in line 2 of the claim. It should read "first and second overhead portion". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-3, 5-6 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a first monitoring parameters" in line 15 of the claim. It is unclear whether it means a single monitoring parameter or a plurality of monitoring parameters. In the first case, it is suggested to use singularity form for 'parameter'. In the second case, it is

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suggested to add a phrase such as 'plurality of' or 'set of' for indicating plurality. Claim 1 recites the limitation "determining a second monitoring parameters" in line 17 of the claim. It is unclear whether it means a single monitoring parameter or a plurality of monitoring parameters. Claim 1 recites the limitation "determining a third monitoring parameters" in line 20 of the claim. It is unclear whether it means a single monitoring parameter or a plurality of monitoring parameters.

6. Claim 5 recites the limitation "said first location" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 6 recites the limitation "said first location" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsushima et al. (U.S. Patent 5,500,756) in view of Chang et al. (U.S. Patent Application Pub. 2002/0112182 A1).

Regarding claim 1, Tsushima et al. discloses in FIG. 35 an optical transmission system with a payload portion (signal) and overhead portion (supervisory and control). FIG. 35 includes operating system 1000 for sending instructions to network elements. FIG. 35 comprises first line terminal 31 (the one on the left-hand side) at the beginning of first optical transmission path (path between first line terminal and first repeater 33), first repeater 33 (the second network

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element counted from left) between the beginning and the end of a second transmission path (path between the two line terminals) and second line terminal 31 (the one on the right-hand side) at the end of third transmission path (the path between second repeater 33 and second line terminal 31). Tsushima et al. teaches in FIG. 42 first overhead portion (first 16 bytes) for storing monitoring information of repeater #1, second overhead portion (second 16 bytes) for storing monitoring information of repeater #2 and third overhead portion (third 16 bytes) for storing third monitoring information signal. Tsushima et al. teaches in col. 32, lines 5-10 that line terminal processes monitor signal. The difference between Tsushima et al. and the claimed invention is that Tsushima et al. does not teach sending instruction for informing monitoring parameters. Chang et al. teaches in paragraph [0017] to configure user-associated monitoring parameters via a network management system. One of ordinary skill in the art would have been motivated to combine the teaching of Chang et al. with the optical transmission system of Tsushima et al. because the approach of Chang et al. is flexible and provides information that is desirable for users. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to send instruction that contains monitoring parameters, as taught by Chang et al., in the optical transmission system of Tsushima et al. because the approach of Chang et al. is flexible and provides information that is desirable for users.

Regarding claims 2-3, Chang et al. teaches in paragraph [0017] to configure user-associated monitoring parameters.

Regarding claims 5-6, Tsushima et al. teaches in FIG. 35 operating system 1000 for sending monitoring instructions and for receiving processing result. Chang et al. teaches in FIG. 2A management server 214 equivalent to the operating system.

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10. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsushima et al. (U.S. Patent 5,500,756) in view of Chang et al. (U.S. Patent Application Pub. 2002/0112182 A1).

Regarding claims 8-9, Tsushima et al. discloses in FIG. 35 an optical transmission system with a payload portion (signal) and overhead portion (supervisory and control). FIG. 35 includes operating system 1000 for sending instructions to network elements. Tsushima et al. teaches in FIG. 42 first overhead portion (first 16 bytes) for storing monitoring information of repeater #1, second overhead portion (second 16 bytes) for storing monitoring information of repeater #2 and third overhead portion (third 16 bytes) for storing third monitoring information signal. Tsushima et al. teaches in col. 32, lines 5-10 that line terminal processes monitor signal. The difference between Tsushima et al. and the claimed invention is that Tsushima et al. does not teach sending instruction for informing monitoring parameters. Chang et al. teaches in paragraph [0017] to configure user-associated monitoring parameters via a network management system. One of ordinary skill in the art would have been motivated to combine the teaching of Chang et al. with the optical transmission system of Tsushima et al. because the approach of Chang et al. is flexible and provides information that is desirable for users. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to send instruction that contains monitoring parameters, as taught by Chang et al., in the optical transmission system of Tsushima et al. because the approach of Chang et al. is flexible and provides information that is desirable for users.

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Regarding claims 10-11, Tsushima et al. teaches in FIG. 35 operating system 1000 for sending monitoring instructions and for receiving processing result. Chang et al. teaches in FIG. 2A management server 214 equivalent to the operating system.

11. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsushima et al. and Chang et al. as applied to claims 1-3, 5-6 and 8-11 above, and further in view of Pick et al. (U.S. Patent 6,826,200 B1).

Tsushima et al. and Chang et al. have been discussed above in regard to claims 1-3, 5-6 and 8-11. The difference between Tsushima et al. and Chang et al. and the claimed invention is that Tsushima et al. and Chang et al. do not teach using used portion of SONET overhead for said overhead portion. Pick et al. teaches in col. 3, lines 53-33 that monitoring information can be transported in SONET network using used overhead bytes of the SONET frame. One of ordinary skill in the art would have been motivated to combine the teaching of Pick et al. with the modified optical transmission system of Tsushima et al. and Chang et al. because using used SONET overhead bytes eliminates the need for an extra channel and reduces cost. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use unused SONET overhead bytes for overhead portion if the optical transmission system is a SONET transmission system, as taught by Pick et al., in the modified optical transmission system of Tsushima et al. and Chang et al. because using used SONET overhead bytes eliminates the need for an extra channel and reduces cost.

Allowable Subject Matter

12. Claims 12-20 and 38 would be allowable if rewritten or amended to properly address the claim objections set forth in this Office action.

Response to Arguments

13. Applicant's arguments with respect to claims 1-3, 5-6, 8-11 and 36-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shi K. Li whose telephone number is 571 272-3031. The examiner can normally be reached on Monday-Friday (8:30 a.m. - 5:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

skl
16 March 2006



Shi K. Li
Patent Examiner